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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,852	12/01/2003	Patricia Ann Piers	AMO10010U-US	2156
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NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304				
EXAMINER				
MATTHEWS, WILLIAM H				
ART UNIT		PAPER NUMBER		
3774				
NOTIFICATION DATE		DELIVERY MODE		
10/31/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/724,852

Applicant(s)

PIERS ET AL.

Examiner

William H. Matthews (Howie)

Art Unit

3774

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-11-08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 216, 219-234, 236, 238-244, 246, 249-255, 257-263 and 265-272 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 216, 219-234, 236, 238-244, 246, 249-255, 257-263 and 265-272 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 216,219-234,236,238-244,246,249-255,257-263, and 265-272 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 216,219,220,222,225-228,233,234,236,238-244,246,250,253-255,257-263,265,266,269, and 270 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosoburd et al (US 5,760,871). Kosoburd discloses a multifocal intraocular lens comprising diffractive and aspheric portions (see col. 6 lines 20-37, columns 15-16, and figures 4B-4C). The diffractive and aspheric portions may be on the posterior and/or anterior surface. As the portions may be on opposing sides, the distribution of light would be 50:50. The limitations regarding the Zernike polynomials and the lens being characterized by conical equations are inherently met because the Zernike polynomials describe spherical aberrations which are reduced and figure 4C show a partially conical shape which may be described by such equations.

4. Claims 216,219,220,221-225, 227-230, 233, 236,238-244, 246,249-253,257,259-263,265,266,269, and 270 are rejected under 35 U.S.C. 102(b) as being anticipated by Lieberman (US 5,800,532). In reference to Figure 7A Lieberman discloses a multifocal intraocular lens 34 comprising a first surface 58 and a second surface 50 wherein the first surface has a first shape and the second surface has a second shape. Furthermore, Lieberman discloses that the IOL (34) can be a toric (aspherical) shape (col. 8, lines 49-67) wherein portion 42 comprises a diffractive pattern (col. 8, lines 45-48) and provides an additional focus to the base focus of the lens (col. 7, lines 18-24) wherein the base focus is 18 diopters (col. 7, lines 50-53) and the additional focus may exceed the base focus by 3 or more diopters (col. 7 lines 45-50). Furthermore, Lieberman discloses an additional focus area which can be greater than 90 degrees, which would occupy more than 30% of the light distribution (col. 7, lines 35-46).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 231 and 232 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman (US 5,800,532).

7. Lieberman discloses an IOL as provided *supra* however Lieberman does not provide the exact thickness of 1.1 millimeters or first and second surfaces

comprising radii of curvature between 12 and 13 millimeters. However, Lieberman does disclose "the relative power and extent (e.g. diameter) of the body portion 52 is chosen based on individual patient considerations, as well known in the art"(col. 6, lines 61-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a thickness of 1.1 millimeters and a first and second surfaces comprising radii of curvature between 12 and 13 millimeters when required by patient needs. The rationale for making the combination being that it would be obvious to try the claimed dimensions within the IOL of Lieberman because the dimensions are compatible with use within a human eye.

8. Claims 221,223-224, 229-232,249, and 251-252 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosoburd et al.(US 5,760,871).

9. Kosoburd discloses an IOL as provided *supra* however Kosoburd does not provide the exact dimensions, materials, or powers. However, Kosoburd does disclose the lens to be designed based on individual patient considerations. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the specific materials, dimensions, and powers as claimed because these would be well-known design considerations in the art of ophthalmology. The rationale for making the modifications being that it would be obvious to try the claimed dimensions within the IOL of Kosoburd because the dimensions are compatible with use within a human eye.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 266,267,268,270,271, and 272 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite "average cornea" or "average eye model" which are indefinite because "average" is not defined in scope within the specification, or define a "modulation transfer function" that is a number (e.g. 0.2 or 0.4) which is indefinite because it is unclear how a function is a number.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Matthews/
Primary Examiner
Art Unit 3774